UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,995	08/15/2001	Noah J. Ternullo	12078-142	9105

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EXAMINER
NANO, SARGON N

ART UNIT	PAPER NUMBER
2157	

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/929,995	TERNULLO ET AL.
	Examiner	Art Unit	
	Sargon N. Nano	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>25 February 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1- 42</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1 -42</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>8/01 ;; 2/05</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

Response to Amendment

1.   This action is responsive to amendment filed on Feb. 25, 2005. Claims 1, 3 – 20

and 22 – 42 were amended. Claims 2 and 21 were cancelled. Claims 43 – 45 were

newly added. Claims 1, 3 – 20, 22 – 45 are pending examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The term "substantially" in claim s15, 23,33 is a relative term which renders the

claim indefinite. The term "substantially" is not defined by the claim, the specification

does not provide a standard for ascertaining the requisite degree, and one of ordinary

skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1, 3-18, 20, 30-31, 36-42 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz et al U. S. Patent No. 6,587,835 (referred to hereafter as Treyz).

As to claim 1,Treyz teaches a method for distributing an advertisement for a service relevant to a location to a client device at the location, said method comprising the steps of:

formatting advertising information from the advertisement into elements, the advertising information including (see col.35 lines 21 – 41 and fig. 37, Treyz discloses services may be displayed as icons on the hand held device);

service information indicating the purpose of the advertisement (see col. 9 line 2 – col. 10 lines 19, Treyz discloses information advertisement that can be viewed and interacted with using handheld system) ;

data entry information indicating purchasing options based on the purpose; and

contact information containing instructions for enabling the client device to communicate with the service(see col. 31 line 66 – col.32 line 22 Treys discloses a data entry option to purchase a product) ;

forming an advertising signal containing the advertising information;

propagating the advertising signal from a transmitter to the client device within the location(see col. 32 lines 23 – 35, Treys discloses the user can obtain advertisement product information when the user is in the vicinity of the a store) ;

receiving the advertising signal at the client device (see col. 31 line 66 – col.32 line 22 Treys discloses advertisement displayed on handheld computing device screen);

decoding the advertising signal to extract said the advertising information(see col. 31 line 66 – col.32 line 22 Treys discloses the user is enabled to check the identities of the retailers and the prices of advertised items) ; and

displaying the advertising information to a user of the client device(see col. 31 line 66 – col.32 line 22 Treyz discloses advertisement information displayed on handheld device).

Treyz teaches the invention as mentioned above. Treyz fails to explicitly teach the use of XML elements, However, " official notice" is taken that both the concept and advantages of using XML elements is well known in the art. It would have been obvious to one of the ordinary skill in the art to format the advertisement information from advertisement into XML elements because it would offer greater flexibility in organizing and presenting information than is possible with the other markup languages , such as HTML.

As to claim 3, Treyz teaches the method of claim 1 further comprising the step of selecting the service based on the advertising information (see col. 50 lines 19 – 37)

As to claim 4, Treyz teaches the method of claim 3 further comprising the step of constructing a user interface for allowing the user to communicate with the client device(see col. 61 – lines 41 – 52 and fig. 108).

As to claim 5, Treyz teaches the method of claim 4 further comprising the step of receiving user inputs in response to the advertising information.(see col. 57 – line 59 – col. 58 line 12).

As to claim 6, Treyz teaches the method of claim 5 further comprising the step of formatting the user inputs and a portion of the advertising information into a user reply, the user reply for making the user inputs available to the service (see col. 59 , lines 46 – 67).

As to claim 7, Treyz teaches the method of claim 6 wherein the user reply is received at the transmitter(see col. 65 lines 11 – 33 and fig. 115).

As to claim 8, Treyz teaches the method of claim 7 wherein the user reply is received as a wireless signal from the client device (see col. 65 lines 11 – 37).

As to claim, 9 Treyz teaches the method of claim 7 wherein the user reply is received at the transmitter using a communication interface providing electromechanical contact between the client device and the transmitter (see col. 16 lines 16 – 22).

As to claim 10, Treyz teaches the method of claim 9 further comprising the step of receiving a service response from the transmitter, the service response including at least one member selected from the group consisting of a graphical representation of the service for display on the client device, executable code for allowing the client device to interact with the service, and text for display on the client device (see col. 16 line 56 – col.17 line 8).

As to claim 11, Treyz teaches the method of claim 6 wherein the user reply is received at a point-of-presence (POP) (see fig 14 , Treyz discloses a communication network).

As to claim 12, Treyz teaches the method of claim 11 wherein the user reply is received over a personal digital assistant (PDA) interface providing electromechanical contact between the client device and the POP(see col. 16 lines 16 – 22).

As to claim 13, Treyz teaches the method of claim 12 further comprising the step of receiving a service response from the POP, the service response including , executable code for allowing the client device to interact with the service(see fig. 19).

As to claim 14, Treyz teaches the method of claim 1 wherein the advertisement is propagated as an optical signal through air(see fig.4).

As to claim 15, Treyz teaches the method of claim 14 wherein the optical signal has a wavelength in the range of substantially 850 nanometers to 1250 nanometers (see col. 12 line 56 – col. 13 line 9).

As to claim 16, Treyz teaches the method of claim 15 wherein the transmitter receives the advertisement over an Internet (see fig.2).

As to claim 17, Treyz teaches the method of claim 15 wherein the transmitter receives the advertisement over a fiber optic network(see col. 12 lines 56 – col. 13 lines 9).

As to claim 18, Treyz teaches the method of claim 1 wherein the client device is a personal digital assistant (PDA)(see fig. 2).

As to claims 20, 30, and 36 Treyz teaches the method of claim 19 wherein said the information is comprised of an XML element.

Treyz teaches the invention as mentioned above. Treyz fails to explicitly teach the use of XML elements, However, " official notice" is taken that both the concept and advantages of using XML elements is well known in the art. It would have been obvious to one of the ordinary skill in the art to format the advertisement information from advertisement into XML elements because it would offer greater flexibility in organizing and presenting information than is possible with the other markup languages , such as HTML.

As to claim 31, Treyz teaches the method of claim 30 wherein the advertisement further comprises:

service information enabling a user of the client device to make a decision about the service provider, the decision being based on the service information(see col. 9 line 2 – col 10 lines 19);

data entry information informing the user about utilizing a service offered by associated with the service provider(see col. 28 line 5 – 29); and

contact information containing instructions for enabling the client device to communicate with the service provider(see col. 28 line 5 – 29).

As to claim 37, Treyz teaches the method of claim 36 wherein the advertisement further comprises:

service information enabling said the user to make a decision about said the

service, said the decision based on said the service information(see col. 31 line 66 –

col.32 line 22);

data entry information informing said the user about utilizing the service; and

contact information containing instructions enabling the client device to

communicate with the service provider(see col. 31 line 66 – col.32 line 22).

As to claim 38, Treyz teaches the method of claim 37 wherein the transmitter

includes an emitter link layer (see fig. 15).

As to claim 39, Treyz teaches the method of claim 38 wherein the client includes

a client device link layer(see fig. 15).

As to claim 40, Treyz teaches the method of claim 39 wherein the emitter link

layer is compatible with the client device link layer(see fig. 15).

As to claim 41, Treyz teaches the method of claim 40 wherein said the

information about the service is displayed to the user if the client device is running a

plug-in cooperatively associated with the service(see col.3, lines 62 – 67).

As to claim 42 , Treyz teaches the method of claim 41 wherein the plug-in further

comprises information about a preference of the user(see col.3, lines 62 – 67).

As to claim 45, Treyz teaches the method of claim 19 wherein the information is

conveyed from said the transmitter as a radio frequency (RF) signal (see col. 19 lines 4

- 17).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.   Claims 19, 22-29, 32-35 and 43-44 are rejected under 35 U.S.C. 102(e) as being

anticipated by Treyz.

As to claim 19, Treyz teaches a method for conveying information comprising

the steps of:

preparing the information including:

service information indicating the purpose of the information(see col. 9 line 2 –

col 10 lines 190);

data entry information indicating purchasing options based on the purpose; and

contact information containing instructions for enabling the client device to

communicate with the service(see col. 28 line 5 – 29);

receiving the information from a service into a transmitter having a link layer

(see col. 31 line 66 – col.32 line 22);

formatting the information for transmission to a client device (see fig. 37)

operating within a context associated with the transmitter(see fig. 37); and

conveying said the information from the transmitter to said the client device over

a communication medium (see col. 31 line 66 – col.32 line 22).

As to claim 22, Treyz teaches the method of claim 19 wherein the information is conveyed from the transmitter as a diffuse infrared signal (see fig. 4).

As to claim 23, Treyz teaches the method of claim 22 wherein the diffuse infrared signal has a wavelength in the range of substantially 850 nanometers to 1250 nanometers(see col. 12 line 56 – col. 13 line 9).

As to claim 24, Treyz teaches the method of claim 19 wherein the client device includes a client device physical layer and a client device link layer compatible with the link layer in the transmitter (see col. 2 lines 12 – 15).

As to claim 25, Treyz teaches a method for interacting with a service provider comprising the steps of:

receiving a broadcast message having service information from a service provider (see col. 9 line 2 – col. 10 lines 19);

creating a service object from the service information;

activating the service object (see col. 30 lines 5-col. 31 lines 65);

receiving user data into the service object (see col. 32 lines 5-55);

sending the user data to the service provider (see col. 10 lines 5-col. 11 lines 65);

receiving service data required to utilize the service from the service provider;

and displaying the service provider data required to utilize the service(see col. 31 line 66 – col.32 line 22).

As to claim 26, Treyz teaches the method of claim 25 further comprising he step of:

displaying an icon associated with the service object(see col. 34 lines 14 – 26).

As to claim 27, Treyz teaches the method of claim 25 wherein the service provider data is displayed using a plug-in cooperatively associated with the service information (see col. 3 lines 62 – 67).

As to claim 28, Treyz teaches the method of claim 27 wherein the plug-in further includes information about a preference of the user(see col. 3 lines 62 – 67).

As to claim 43, Treyz teaches the method of claim 25 further comprising the steps of:

displaying the service provider data on a wearable device; and receiving user data from voice, fingers, or eye movement (see col. 16 lines 37 – 55).

As to claim 44, Treyz teaches the method of claim 25 further comprising the steps of: displaying the service provider data on a device mounted in a vehicle; and

receiving information pertaining to the location of the vehicle through an IR communication interface(see col. 19 lines 4 – 17).

As to claim 29, Treyz teaches a method of utilizing executable code in a transmitter for providing an advertisement to a client device said method comprising the steps of:

receiving the advertisement from a service provider, about a service offered by said the service provider(see col. 31 line 66 – col.32 line 22);

formatting the advertisement for transmission to the client device operating within a coverage area of the transmitter(see col.35 lines 21 – 41 and fig. 37); and

conveying the advertisement from the transmitter to the client device over a communication medium(see col. 31 line 66 – col.32 line 22).

As to claim 32 Treyz teaches the method of claim 29 wherein the advertisement is conveyed from the transmitter as a diffuse infrared signal(see fig. 4).

As to claim 33, Treyz teaches the method of claim 32 wherein the diffuse infrared signal has a wavelength in the range of substantially 850 nanometers to 1250 nanometers(see col. 12 line 56 – col. 13 line 9).

As to claim 34, Treyz teaches the method of claim 33 wherein the diffuse infrared signal is generated by modulating an electric light(see col. 12 line 56 – col. 13 line 9).

As to claim 35, Treyz teaches a method of utilizing executable code in a client device receiving an advertisement from a transmitter, said method comprising the steps of:

receiving the advertisement from an infrared communication signal conveyed from said the transmitter and arriving at a communication interface associated with the client device, the advertisement containing at least a portion of a service offered by a service provider(see col. 9 line 2 – col. 10 lines 19);

decoding the advertisement to extract information contained therein;

processing the information; and displaying said the information to a user of said the client device(see col. 31 line 66 – col.32 line 22);

displaying the information to a user of the client device(see col. 31 line 66 - col.32 line 22).

Response to Arguments

4 Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sargon N. Nano whose telephone number is (571) 272-4007. The examiner can normally be reached on 8 hour.
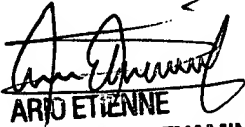
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Sargon Nano

May 11, 2005

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